



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/589,626	06/07/2000	Ronald A. Schachar	PRES06-00147	8612

7590 08/14/2003

NOVAKOV, DAVIS & MUNCK, P.C.
900 THREE GALLERIA TOWER
13155 NOEL ROAD
DALLAS, TX 75240

EXAMINER

WILLSE, DAVID H

ART UNIT

PAPER NUMBER

3738

DATE MAILED: 08/14/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	SCHACHAR, RONALD A.
09/589,626	
Examiner	Art Unit
Dave Willse	3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 01 July 2003.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-24 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) 22-24 is/are allowed.

6) Claim(s) 1-21 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____.
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) Other: _____

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-21 are rejected under 35 U.S.C. 101 because of the positive recitation of the sclera, ocular tissue, and other natural parts of the body (MPEP 2105, last paragraph).

Recommendations on how to rectify these types of problems are set forth in the previous Office action (Paper No. 10).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 and 12-17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Schachar, US 5,354,331. Embodiments described at column 7, lines 1-12, clearly possess at least one pair of ends (column 7, lines 6-8) and a planform defining contact surfaces and at least one diameter so as to expand the sclera to increase the effective working distance of the ciliary muscles of the eyeball, especially when the band is used in the manner discussed at column 7, lines 36-42.

Claims 8-11 and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schachar, US 5,354,331. Complementary concave and convex surfaces at the ends of the band would have been obvious in order that the overlapping “ends may slide past one another” (column 7, lines 6-7) and “[t]he length of the overlap may be adjusted” (column 7, lines 8-9) while maintaining a ring-like shape (via the tracking of the engaging concave and convex surfaces) and a substantially uniform thickness, such being especially desirable when the band is positioned within the sclera (column 7, line 37).

Claims 22-24 are allowed.

The Applicant’s remarks have been reviewed. The Applicant states that “[t]here is no first end and there is no second end of the scleral expansion band described in the *Schachar* reference” (Paper No. 12, page 16, lines 7-8) and thus ignores the embodiment that is explicitly characterized as having ends (column 7, lines 6-8). Moreover, it must be pointed out that the transitional term “comprising” is “inclusive or open-ended and does not exclude additional, unrecited elements” (MPEP 2111.03). Therefore, even though the scleral expansion band mentioned at column 7, lines 1-3, for example, is ring-like in form, it comprises a plurality of parts or bodies, each of which has first and second ends, a planform, and other features set forth in present claim 1 and others.

Regarding the obviousness rejection under 35 U.S.C. 103(a), since Schachar ‘331 does not illustrate the embodiments presented at column 7, lines 1-12, the ordinary practitioner would have been left to devise an appropriate modular and/or adjustable structure. The Applicant apparently wants the examiner to believe that one of ordinary skill (the level of which is quite high in this particular art) would not have been imaginative enough to come up complementary

concave and convex tracking surfaces. The examiner disagrees but, nonetheless, hereby cites US 5,323,788 (Figures 8A and 8C; column 8, lines 23-38) to show that such a design was available and taught in the art.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse, who is available Monday through Thursday and whose telephone number is (703) 308-2903. The supervisor, Corrine McDermott, can be reached at (703) 308-2111. The receptionist's phone number is (703) 308-0858, and the main FAX numbers are (703) 305-3591, 3590.

dhw: D. Willse
August 12, 2003



DAVE WILLSE
PRIMARY EXAMINER
ART UNIT 3738